

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JOHN M. ROBINSON, TAMI J. PILOT-MATIAS  
and JEFFREY C. HUNT

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Appeal No. 95-1463  
Application No. 07/779,704<sup>1</sup>

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ON BRIEF

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Before WINTERS and GRON, Administrative Patent Judges, and  
McKELVEY, Senior Administrative Patent Judge.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal was taken from the examiner's decision rejecting claims 5 through 10, 39, and 41 through 49. Claims 11 through 38 and 40, which are the only other claims

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<sup>1</sup> Application for patent filed October 21, 1991.

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remaining in the application, stand withdrawn from further consideration by the examiner as directed to a non-elected invention.

Initially, we note that appellants have withdrawn the appeal of claims 41 through 43 (Appeal Brief, paragraph bridging pages 1 and 2). Accordingly, with respect to claims 41 through 43, the appeal is dismissed. We also note that the examiner entered a new ground of rejection of claims 5 through 8, 39, and 44 through 49 under 35 U.S.C. § 112, second paragraph (Examiner's Answer, section (10) entitled "New Ground of Rejection"). In the Answer, page 9, the examiner states as follows:

In view of the new ground of rejection, Appellants are given a period of TWO MONTHS from the mailing date of this examiner's answer within which to file a reply to any new ground of rejection. Such reply may include any amendment or material appropriate to the new ground of rejection. Prosecution otherwise remains closed. Failure to respond to the new ground of rejection will result in dismissal of the appeal of the claims so rejected.

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Appellants failed to respond to the new ground of rejection and, accordingly, the appeal with respect to claims 5 through 8, 39, and 44 through 49 is also dismissed.<sup>2</sup>

Claims 9 and 10 read as follows:

9. Recombinant fusion protein p776.

10. Recombinant fusion protein p410.

The references relied on by the examiner are:

J. Sambrook et al. (Sambrook), Molecular Cloning: A Laboratory Manual, pp. 17.2-17.9 (2d ed., Cold Spring Harbor Laboratory Press 1989)

Gabriele S. Gassmann et al. (Gassmann), "Analysis of the Borrelia burgdorferi GeHo fla Gene and Antigenic Characterization of Its Gene Product," 173 Journal of Bacteriology no. 4, 1452-59 (Feb. 1991)

The issue presented for review is whether the examiner erred in rejecting claims 9 and 10 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Gassmann and Sambrook.

#### DISCUSSION

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<sup>2</sup> On July 21, 1998, Pamela S. Bennett, paralegal with the Board of Patent Appeals and Interferences, spoke on the telephone with Cheryl L. Becker, Registration No. 35,441, counsel for appellants. In that telephone conversation, counsel indicated that no Reply Brief was filed in response to the new ground of rejection and that claims 9 and 10 are the only claims remaining on appeal.

Gassmann discloses a series of overlapping octapeptides representing the entire sequence of Borrelia burgdorferi flagellin protein. In Figure 7 and in the accompanying text at page 1458, column 1, first full paragraph, Gassmann focuses attention on amino acids 180-260 in the sequence. At best, Gassmann constitutes an invitation for a person having ordinary skill to explore "this region," defined by amino acids 180-260, in search of a suitable diagnostic oligopeptide. Note these statements in Gassmann: (1) "This region could constitute a candidate antigen for more specific and sensitive serodiagnosis of Lyme borreliosis" (Gassmann, abstract, last sentence, emphasis added); and (2) "this region might therefore be suitable for synthesis of a longer, diagnostic oligopeptide" (Gassmann, page 1458, column 1, first full paragraph, emphasis added).

In our judgment, the Gassmann reference constitutes insufficient evidence to support a conclusion of obviousness of claim 9, drawn to recombinant fusion protein p776, or claim 10, drawn to recombinant fusion protein p410. The proteins p410 and p776 represent amino acids 137-262 and 64-311 of the Borrelia burgdorferi sequence, respectively (specification,

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page 7, first full paragraph). As correctly pointed out by appellants, the claimed proteins include a number of amino acids outside the region of interest postulated by Gassmann, namely, amino acids 180-260 (Appeal Brief, paragraph bridging pages 6 and 7). On these facts, we find that Gassmann would not have led a person having ordinary skill in the art from "here to there," i.e., from the region of interest identified by Gassmann (page 1458, column 1, first full paragraph) to the claimed proteins. Nor does Sambrook cure the above-noted deficiency in Gassmann. Accordingly, the examiner's decision rejecting claims 9 and 10 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Gassmann and Sambrook is reversed.

The appeal with respect to claims 5 through 8, 39, and 41 through 49 is dismissed. The examiner's decision rejecting claims 9 and 10 under 35 U.S.C. § 103 is reversed.

REVERSED

SHERMAN D. WINTERS )  
Administrative Patent Judge )  
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PATENT	TEDDY S. GRON	)	BOARD OF
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	FRED E. McKELVEY	)	
	Senior Administrative Patent Judge	)	

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